

ESTTA Tracking number: **ESTTA497999**

Filing date: **10/03/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Mitsubishi Kakoki Kabushiki Kaisha Mitsubishi Jukogyo Kabushiki Kaisha
Granted to Date of previous extension	10/03/2012
Address	Chiyoda-Ku Tokyo, JAPAN
Party who filed Extension of time to oppose	Mitsubishi Kakoki Kabushiki Kaisha Mitsubishi Kakoki Kabushiki Kaisha
Relationship to party who filed Extension of time to oppose	Since the TTAB e-Form for a Request for Extension of Time to Oppose has only one field for the potential opposer's name, we stated Mitsubishi Kakoki Kabushiki Kaisha. However, Mitsubishi Jukogyo Kabushiki Kaisha is a joint owner of the registration which our client is basing the opposition on.
Attorney information	Anthony F. Lo Cicero AMSTER ROTHSTEIN & EBENSTEIN LLP 90 PARK AVE NEW YORK, NY 10016 UNITED STATES ptodocket@arelaw.com Phone:2123368000

### Applicant Information

Application No	85400838	Publication date	06/05/2012
Opposition Filing Date	10/03/2012	Opposition Period Ends	10/03/2012
International Registration No.	NONE	International Registration Date	NONE
Applicant	Automotive & Tractor Spares England 114 Rowlands Avenue Pinner Middlesex, HA54AP UNITED KINGDOM		

### Goods/Services Affected by Opposition

Class 007.


All goods and services in the class are opposed, namely: Automotive engine blocks; Axles for machines; Ball bearings for use in machines, namely, diesel engines and tractors; Bearings for transmission shafts, being parts of machines; Bearings, as parts of machines; Belts for engines; Brakes for machines; Brushes being parts of motors, generators and dynamos; Combustion engine fuel nozzles; Connecting rods for machines, motors and engines; Crank shafts for diesel engines and tractors; Crankcases for machines, motors and engines; Cylinder heads for engines; Cylinders for

motors and engines; Diesel engines for machines; Disc brakes for machines; Electric starter motors; Engine bearings; Engine cylinders for land vehicles; Engine cylinders for vehicles; Engine injectors; Engine parts, namely, electronic fuel injection modules; Fan belts for motors and engines; Fuel injector parts for land and water vehicle engines; Fuel injectors; Fuel pumps for land vehicles; Gaskets for internal combustion engines; Hydraulic pumps; Internal combustion engine parts, namely, heads; Internal combustion engine parts, namely, piston rings; Internal combustion engine parts, namely, pistons; Internal combustion engines for machine operation and replacement parts therefor; Internal combustion land vehicle engine parts, namely, connecting rods; Land vehicle parts, namely, spark plug wires; Machine parts, namely, bearings and bushings; Machine parts, namely, cylinders; Metal engine gaskets for vehicles; Non-metal engine gasket for vehicles; Oil filters for motors and engines; Oil pumps for land vehicles; Oil pumps for use in motors and engines; Piston rings; Pistons for diesel engines and tractors; Power transmission belts for machines; Pump control valves; Pumps and compressors as parts of machines, motors and engines; Pumps as parts of machines, motors and engines; Roller bearings for machines; Self-lubricating mechanical friction parts, especially of composite materials, namely, wear rings, washers, bushings, spherical bearings, bearing pads, sliding blocks and machine transmission gears all for load bearing machines, conveyors, handling trucks and machines, lifting machines, agricultural machinery, construction equipment machines and hydraulic turbines; Shaft couplings as parts of machines; Shaft couplings for machines; Shafts for pumps; Spark plugs; Starter motors; Starters for motors and engines; Transmission gears for machines; Valves being engine parts for introducing fuel-air mixtures into the combustion chambers of internal combustion engines; Valves for pumps; Water pumps for land vehicles; Water pumps for use in motors and engines; all of the foregoing for agricultural tractors, automotive applications and diesel engines

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

## Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	970665	Application Date	09/15/1971
Registration Date	10/16/1973	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U023 (International Class 007, 009). First use: STEAM TURBINES, GAS TURBINES, WATER TURBINES, DIESEL ENGINES, KEROSENE ENGINES, GASOLINE ENGINES, CENTRIFUGAL COMPRESSOR, ROLLING MILL AND THE OTHER METAL-WORKING MACHINE, AND PARTS THEREFOR, MINING MACHINES, AND PARTS THEREFOR, POWER SHOVEL, MOTOR GRADER, MOTOR SCRAPER, TRACTOR SHOVEL, BULLDOZER, PILE HAMMER, BORING MACHINE, ASPHALT FINISHER, TIRE ROLLER, TUNNEL BORING MACHINE, [		

	<p>TIMBERING, WOODWORKING OR PLYWOOD MACHINES, ] AND PARTS THEREFOR, PULP MANUFACTURING MACHINES, AND PARTS THEREFOR, PAPER MAKING MACHINES, AND PARTS THEREFOR, PLASTIC INJECTION MOLDING MACHINES, PAPER BOX MANUFACTURING MACHINE, PRINTING MACHINES, AND PARTS THEREFOR, AUTOMATIC VENDING MACHINE, AGRICULTURAL MACHINES, AND PARTS THEREFOR, BOTTLING MACHINES, POWER CONDUCTION EQUIPMENT-NAMELY, WORM GEAR REDUCER AND STEPLESS VARIABLE SPEED GEAR</p> <p>Class U034 (International Class 011). First use:</p> <p>AIR CONDITIONING APPARATUS AND PARTS THEREFOR</p>
--	------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

Attachments	<p>72402774#TMSN.gif ( 1 page )( bytes )</p> <p>Notice of Opposition Mitsubishi.pdf ( 8 pages )(309031 bytes )</p>
-------------	--------------------------------------------------------------------------------------------------------------------

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Anthony F. Lo Cicero/
Name	Anthony F. Lo Cicero
Date	10/03/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

----- x

MITSUBISHI KAKOKI KABUSHIKI KAISHA :  
and :  
MITSUBISHI JUKOGYO KABUSHIKI KAISHA, :

Opposition No.

**NOTICE OF OPPOSITION**

Opposers,

v.

AUTOMOTIVE & TRACTOR SPARES  
ENGLAND,

Applicant.


----- x

In the matter of U.S. Trademark Application Serial No. 85/400,838 filed by Automotive & Tractor Spares England, Ayesha Khan (“Applicant”) on August 18, 2011 and published for opposition in the June 5, 2012 issue of the Official Gazette of the United States Patent and Trademark Office for the mark ATS & Three Diamond Design (the “Accused Mark”) in connection with Automotive engine blocks; Axles for machines; Ball bearings for use in machines, namely, diesel engines and tractors; Bearings for transmission shafts, being parts of machines; Bearings, as parts of machines; Belts for engines; Brakes for machines; Brushes being parts of motors, generators and dynamos; Combustion engine fuel nozzles; Connecting rods for machines, motors and engines; Crank shafts for diesel engines and tractors; Crankcases for machines, motors and engines; Cylinder heads for engines; Cylinders for motors and engines; Diesel engines for machines; Disc brakes for machines; Electric starter motors; Engine bearings; Engine cylinders for land vehicles; Engine cylinders for vehicles; Engine injectors; Engine parts, namely, electronic fuel injection modules; Fan belts for motors and engines; Fuel injector parts for land and water vehicle engines; Fuel injectors; Fuel pumps for land vehicles; Gaskets for internal combustion engines; Hydraulic pumps; Internal combustion engine parts, namely, heads;

Internal combustion engine parts, namely, piston rings; Internal combustion engine parts, namely, pistons; Internal combustion engines for machine operation and replacement parts therefor; Internal combustion land vehicle engine parts, namely, connecting rods; Land vehicle parts, namely, spark plug wires; Machine parts, namely, bearings and bushings; Machine parts, namely, cylinders; Metal engine gaskets for vehicles; Non-metal engine gasket for vehicles; Oil filters for motors and engines; Oil pumps for land vehicles; Oil pumps for use in motors and engines; Piston rings; Pistons for diesel engines and tractors; Power transmission belts for machines; Pump control valves; Pumps and compressors as parts of machines, motors and engines. Pumps as parts of machines, motors and engines; Roller bearings for machines; Self-lubricating mechanical friction parts, especially of composite materials, namely, wear rings, washers, bushings, spherical bearings, bearing pads, sliding blocks and machine transmission gears all for load bearing machines, conveyors, handling trucks and machines, lifting machines, agricultural machinery, construction equipment machines and hydraulic turbines; Shaft couplings as parts of machines; Shaft couplings for machines; Shafts for pumps; Spark plugs; Starter motors; Starters for motors and engines; Transmission gears for machines; Valves being engine parts for introducing fuel-air mixtures into the combustion chambers of internal combustion engines; Valves for pumps; Water pumps for land vehicles; Water pumps for use in motors and engines; all of the foregoing for agricultural tractors, automotive applications and diesel engines (the "Subject Application").

As grounds for opposition of the Subject Application, Opposers, Mitsubishi Kakoki Kabushiki Kaisha and Mitsubishi Jukogyo Kabushiki Kaisha ("Opposers"), by and through their attorneys, allege as follows:

1. Opposers, Japanese corporations maintaining a place of business at Chiyoda-Ku, Tokyo, Japan, believe that they will be damaged by the registration of the Subject Application and hereby oppose the same.

2. Opposers own the well-known trademark and service mark  in connection with steam turbines, gas turbines, water turbines, diesel engines, kerosene engines, gasoline engines, centrifugal compressor, rolling mill and the other metal-working machine, and parts therefor, mining machines, and parts therefor, power shovel, motor grader, motor scraper, tractor shovel, bulldozer, pile hammer, boring machine, asphalt finisher, tire roller, tunnel boring machine, timbering, woodworking or plywood machines, and parts therefor, pulp manufacturing machines, and parts therefor, paper making machines, and parts therefor, plastic injection molding machines, paper box manufacturing machine, printing machines, and parts therefor, automatic vending machine, agricultural machines, and parts therefor, bottling machines, power conduction equipment-namely, worm gear reducer and stepless variable speed gear in International Classes 7 and 9 and air conditioning apparatus and parts therefor in International Class 11 (the "Subject Mark").

3. The Subject Mark has been in use for several decades.

4. Opposers own several U.S. Registrations for the Subject Mark, including Registration No. 970,665 of October 16, 1973.

A copy of this Registration is annexed hereto as Exhibit A.

5. Products and services provided under the Subject Mark have been advertised to the trade and purchasing public and have been the subject of unsolicited media attention.

6. The Subject Mark, by reason of the high quality of products and services provided under the Subject Mark, has come to be known to the purchasing public as representing products

and services of the highest quality. As a result thereof, the Subject Mark and the goodwill associated therewith are of inestimable value to Opposers.

7. By virtue of the renown acquired by the Subject Mark, coupled with Opposers' reputation for high quality products and services, the Subject Mark has acquired secondary meaning and has developed an enviable reputation in the minds of the purchasing public.

8. Long after Opposers commenced use of and applied to register the Subject Mark, and long after the Subject Mark became well known to consumers, Applicant applied to register the Accused Mark.

9. The Accused Mark is confusingly similar to the Subject Mark. The design elements of the two marks are identical and the goods/services are clearly related.

10. Based on the foregoing, the use and/or registration of the Accused Mark by Applicant is likely to cause confusion and mistake in the minds of the purchasing public, and, in particular, will, upon information and belief, tend to falsely create the impression that the products sold under the Accused Mark are authorized, sponsored, or approved by Opposers when, in fact, they are not.

11. Accordingly, it is Opposers' belief that if Applicant is granted registration of the Application opposed herein, Opposers will suffer irreparable harm and damage.

\* \* \* \* \*

**WHEREFORE**, Opposers respectfully request that the mark shown in U.S. Trademark Application Serial No. 85/400,838 be refused registration and that this Opposition be sustained.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP  
Attorneys for Opposers  
Mitsubishi Kakoki Kabushiki Kaisha and  
Mitsubishi Jukogyo Kabushiki Kaisha  
90 Park Avenue  
New York, New York 10016  
(212) 336-8000

Dated: New York, New York  
October 3, 2012

By: 

\_\_\_\_\_  
Anthony F. Lo Cicero



**CERTIFICATE OF SERVICE**

I hereby certify that true and complete copy of the foregoing NOTICE OF OPPOSITION has been served on Applicant by delivering said copy, via Federal Express, to Applicant, as follows:

Ayesha Khan  
Automotive & Tractor Spares England  
114 Rowlands Avenue, Pinner  
Middlesex HA5 4AP  
UNITED KINGDOM  
Tel: 00442084216288  
Fax: 0442084212361  
E-Mail: info@atsengland.com

  
\_\_\_\_\_  
Anthony F. Lo Cicero

Dated:     October 3, 2012  
          New York, New York

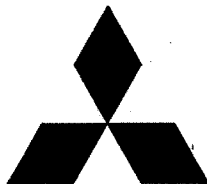
# **EXHIBIT A**

# United States Patent Office

970,665  
Registered Oct. 16, 1973

## PRINCIPAL REGISTER Trademark

Ser. No. 402,774, filed Sept. 15, 1971



Mitsubishi Kakoki Kabushiki Kaisha (Japanese corporation)  
6, Marunouchi 2-chome  
Chiyoda-ku, Tokyo, Japan

For: STEAM TURBINES, GAS TURBINES, WATER TURBINES, DIESEL ENGINES, KEROSENE ENGINES, GASOLINE ENGINES, CENTRIFUGAL COMPRESSOR, ROLLING MILL AND THE OTHER METAL WORKING MACHINE, AND PARTS THEREFOR, MINING MACHINES, AND PARTS THEREFOR, POWER SHOVEL, MOTOR GRADER, MOTOR SCRAPER, TRACTOR SHOVEL, BULLDOZER, PILE HAMMER, BORING MACHINE, ASPHALT FINISHER, TIRE ROLLER, TUNNEL BORING MACHINE, TIMBERING, WOODWORKING OR PLYWOOD MACHINES, AND PARTS THEREFOR, PULP MANUFACTURING MACHINES,

AND PARTS THEREFOR, PAPER MAKING MACHINES, AND PARTS THEREFOR, PLASTIC INJECTION MOLDING MACHINES, PAPER BOX MANUFACTURING MACHINE, PRINTING MACHINES, AND PARTS THEREFOR, AUTOMATIC VENDING MACHINE, AGRICULTURAL MACHINES, AND PARTS THEREFOR, BOTTLING MACHINES, POWER CONDUCTION EQUIPMENT—NAMESLY, WORM GEAR REDUCER AND STEP-LESS VARIABLE SPEED GEAR—in CLASS 23 (INT. CLS. 7 and 9).

For: AIR CONDITIONING APPARATUS AND PARTS THEREFOR, in CLASS 34 (INT. CL. 11).

Owner of Japanese Reg. No. 441,379, dated Mar. 3, 1954; and U.S. Reg. No. 916,237.

G. R. LEADER, Examiner